

## **REMARKS**

### **I. Introduction**

In a Decision mailed on March 31, 2009, the Board of Patent Appeals and Interferences ("the Board"): (1) reversed the rejections of claims 1-17 under 35 U.S.C. § 112, second paragraph; (2) affirmed the rejection of claims 9-10 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,549,922 ("Srivastava"); (3) entered a sua sponte rejection of claims 1-8 and 11-17 under 35 U.S.C. § 101; and (4) did not reach the prior art rejections<sup>1</sup> applied against claims 1-8 and 11-17 in view of the Board's sua sponte rejection of claims 1-8 and 11-17.

Applicants herein amend claims 1 and 9-17 to clarify the subject matter for which applicants seek protection. Claims 1-17 are pending. For reasons discussed in detail below, applicants respectfully submit that the pending claims are in condition for allowance.

### **II. Rejections under 35 U.S.C. § 101**

#### **A. Claims 1-8**

The Board rejected claims 1-8 sua sponte under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Decision, March 31, 2009, pp. 9-11). Although applicants disagree with the propriety of this rejection, applicants have amended independent claim 1 to recite that the method is performed by a computing system and "code implementing the method is stored in memory of the computing system for execution by a processor of the computing system." Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-8 under 35 U.S.C. § 101.

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<sup>1</sup> Claims 1-3, 5-8, 11, and 13-17 were rejected under 35 U.S.C. § 102(e) over Srivastava; claims 4 and 12 were rejected under 35 U.S.C. § 103(a) over a combination of Srivastava and U.S. Patent No. 6,943,720 ("Chu").

B. Claims 11-17

The Board rejected claims 11-17 sua sponte under 35 U.S.C. 101 for reciting a data signal (Decision, March 31, 2009, pp. 11-12). Although applicants disagree with the propriety of this rejection, applicants have amended claims 11-17 to recite a data transmission network conveying computer-executable instructions. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 11-17 under 35 U.S.C. § 101.

III. Rejections under 35 U.S.C. §§ 102(e) and 103(a)

A. Claims 9-10

The Board affirmed the rejection of claims 9 and 10 under 35 U.S.C. § 102(e) over Srivastava (Decision, March 31, 2009, p. 9). The Board took the position that a user operating a client computer corresponds to applicants' "authoritative source", as recited by independent claims 9 and 10 (*id.* pp. 6, 8 citing Srivastava 4:14-19). In particular, the Board stated that:

Srivastava discloses that the user can edit a value (e.g., "QuickTime file" in Figure 2). The client computer compares the contents of the present field of metadata with contents of a field provided by **an authoritative source—i.e., the user**—by means of the GUI. The client computer modifies the metadata (e.g., "QuickTime file" value) if the present (compared) field contents do not match the field contents entered by the user.

(*id.* p. 8; emphasis added). Although applicants disagree with the Board's interpretation of Srivastava, applicants herein amend independent claims 9 and 10 to clarify the subject matter for which applicants seek protection. As amended, these claims recite that the authoritative source is a database. Therefore, applicants submit that independent claims 9 and 10 are patentable over Srivastava. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 9-10 under 35 U.S.C. § 102(e) over Srivastava.

B. Claims 1-8 and 11-17

The Board did not reach the prior art rejections applied against claims 1-8 and 11-17 in view of the Board's sua sponte rejection of these claims under 35 U.S.C. § 101 (Decision, March 31, 2009, p. 12). Independent claims 1 and 11 recite "compare[ing] contents of each of said at least one field of metadata with contents of at least one field of metadata from an authoritative source...wherein the authoritative source is a source other than a person; and modify[ing] said metadata if said compared field contents do not match the contents of at least one field of authoritative metadata" (emphasis added). For similar reasons to those discussed above with respect to independent claims 9 and 10, applicants submit that independent claims 1 and 11 are patentable over Srivastava. Moreover, applicants submit that Chu does not supply the missing elements of Srivastava. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-3, 5-8, 11, and 13-17 under 35 U.S.C. § 102(e) over Srivastava, and the rejection of claims 4 and 12 under 35 U.S.C. § 103(a) over the combination of Srivastava and Chu.

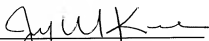
IV. Conclusion

In view of the above amendment and remarks, applicants believe the pending application is in condition for allowance. If the Examiner has any questions or believes a telephone conference would expedite examination of this application, the Examiner is encouraged to call the undersigned directly at (206) 359-8077.

Please charge any deficiencies, or credit any overpayment, to our Deposit Account No. 50-0665, under Order No. 283108007US from which the undersigned is authorized to draw.

Dated: May 11, 2009

Respectfully submitted,

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